

## REMARKS

Claims 1-23 are pending in the application. In the final Office action dated October 20, 2003, claims 1-13 and 18-22 are allowed, claims 14-17 and 23 are rejected under et U.S.C. § 112, second paragraph, as being indefinite; and claims 14-16 are rejected under 35 U.S.C. § 102(b) as being anticipated by Maki (U.S. Patent No. 5,639,522). In view of the above amendments and the remarks that follow, Applicant respectfully requests reconsideration of the finally rejected claims.

### ***Rejections under 35 U.S.C. § 112***

Claims 14-17 and 23 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully disagrees.

The action indicates that claim 14 is unclear as to whether it is directed to a fastener, or to a combination of a fastener and fastener holder. Applicant submits that claim 14 is directed to a fastener, as is made clear by the preamble of the claim.

Fasteners typically serve to fasten a first article to a second article. That is, the fastener is attached to the first article to be fixed (in this case corresponding to the molding of the present invention) by means of an engaging mechanism between the fastener and the first article. Then, the first article is attached to the second article (in this case corresponding to the car body) by the fastener by means of an engaging mechanism between the fastener and the second article.

Although claim 14 is directed to the fastener, the applicant suggests that the

fastener may be properly defined by the nature of its interaction with the first article. For example, the fastener of the present invention includes elastic pieces 34 configured to securely attach the fastener to the fastener holder of the molding, and yet also permit the molding to be easily released from fastener.

The applicant disagrees that reference to the article to be fixed renders the claim indefinite under 35 U.S.C. § 112, second paragraph. The Court of Appeals for the Federal Circuit has determined that claim elements that are defined with respect to an unclaimed, and even variable object need not be indefinite (see MPEP § 2173.05(b)). In *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.* (806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986)), a claim limitation specifying that a certain part of the claimed wheelchair be "so dimensioned as to be insertable through the space between the doorframe of an automobile and one of the seats" was held to be definite. The court stated that the decision on whether a claim is invalid under § 112, second paragraph requires only a determination of whether those skilled in the art would understand what is claimed when the claim is read in light of the specification. Specifically, *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.* state that "patent law does not require that all possible lengths corresponding to the spaces in hundreds of different automobiles be listed in the patent, let alone that they be listed in the claims." Similarly, applicant's fastener is properly defined relative to the fastener holder, without claiming the fastener holder itself, as would be well-understood by one of ordinary skill in the art in view of the guidance of the specification.

Nevertheless, in the interest of furthering the prosecution of the application,

applicant has amended claims 14-17 to delete the details of the fastener holder, in order to more particularly define the fastener that they regard as their invention.

In view of the above remarks and amendments, the applicant suggests that the claims define the applicant's invention with particularity, and request the withdrawal of the rejection of claims 14-17 and 23 under 35 U.S.C. § 112, second paragraph.

### ***Rejections under 35 USC § 102***

Claims 14-16 are rejected under 35 U.S.C. § 102(b) as being anticipated by Maki (U.S. Patent No. 5,639,522). Applicant traverses the rejection.

The action states that Maki teaches a base plate 152, an engaging portion 154 that projects upright from the base plate, a pair of extending elastic pieces 156 whose ends are free, and protruding portions (outer portions) formed to the elastic pieces. Applicant suggests that Maki fails to disclose each and every element of the claims.

Claim 14 recites a fastener for fastening said molding main body to a car body that is held in place by a fastener holder. The fastener includes a base plate that is inserted into a housing space inside the fastener holder, an engaging portion that projects upright from the base plate, and a pair of extending elastic pieces having protruding portions. Unlike the side molding of Maki, the fastener of claim 14 is configured to engage "in a releasable manner" with the fastener holder. Referring to the specification at page 3, lines 12-17, the present invention permits automobile molding to be securely attached to the fastener, and yet "the fastener can be easily separated from the molding main body without causing damage to the parts due to cutting, etc., so that, following separation, both parts can be recycled." More specifically, in the specification at page 22, lines 1-4,

"In this automobile molding 20, the engagement between protruding portions 34b and engaging holes 37 is released due to the elastic deformability of elastic pieces 34. Thus fastener 23 can be separated from molding main body 21 without damaging the parts by cutting, etc."

The molding clip of Maki is explicitly disclosed as permanently mounting to the molding. For example as disclosed at col. 7, lines 37-53 of Maki:

"As the seat 152 of the clip 150 is inserted at the opening of the clip holder 140, the insert section 159 of the seat 152 pushes to spread the claws 148 of the clip holder 140 sideward, elastically deforming each longitudinal side wall 142. When the rear end of the insert section 159 of the seat 152 has passed completely over the part of the claws 148, a pair of longitudinal side walls 142 that have been spread sideward by elastic deformation will recover the original form, *thereby locking by the pair of claws 148 so that the seat 152 can not be released* along the direction of insertion and at the same time the pair of retaining plates 146 are also *locked so that the seat 152 can not be released* out along the direction intersecting at right angles with the direction of insertion, thus mounting the clip 150 to the clip holder 140." (emphasis added)

Once clip 150 of Maki has been inserted into clip holder 140 of the molding, clip 150 cannot be released from clip holder 140. However, the fastener recited in claim 14 is configured the fastener holder "in a releasable manner." Applicant suggests that the Maki reference fails to disclose each and every element of claim 14, and so fails to anticipate the subject matter of the claim.

As claims 15 and 16 depend from and otherwise include each element of claim 14, applicant suggests that claims 14-16 are not anticipated by the Maki reference, and respectfully request the withdrawal of the rejection of claims 14-16 under 35 U.S.C. § 102(b).

***Allowable Subject Matter***

Applicant is grateful for the indication that claims 1-13 and 18-22 are allowable, and that claims 17 and 23 would be allowable if rewritten to overcome the rejections under 35 U.S.C. § 112, second paragraph.

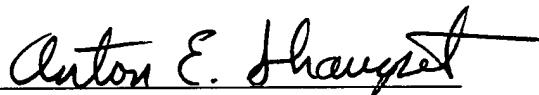
As the above amendments and remarks should be sufficient to overcome the rejections of claims 14-17 and 23, applicant suggests that claims 1-23 are in condition for allowance. A prompt indication of the same respectfully is requested. The Examiner is encouraged to telephone the undersigned if any issues remain that may be resolved by a telephonic interview.

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Alexandria, Virginia 22313, on January 20, 2004.

  
\_\_\_\_\_  
George Painter  
Date of Signature: January 20, 2004

Respectfully submitted,  
KOLISCH HARTWELL, P.C.

  
\_\_\_\_\_  
Anton E. Skaugset  
Customer No. 23581  
Registration No. 38,617  
of Attorneys for Applicant  
520 S.W. Yamhill Street, Suite 200  
Portland, Oregon 97204  
Telephone: (503) 224-6655  
Facsimile: (503) 295-6679